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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,354	03/09/2001	Steven A. Sunshine	18564I008110	7440

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Foley & Lardner  
Suite 500  
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Washington, DC 20007

EXAMINER

O'CONNOR, GERALD J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/802,354

Applicant(s)

Sunshine et al.

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on August 11, 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 56-58 is/are pending in the application.
- 4a) Of the above claim(s) 57 and 58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Preliminary Remarks***

1. This Office action responds to the amendment and arguments filed by applicant on August 11, 2004 in reply to the previous Office action, mailed February 12, 2004.
2. The amendment of claims 1 and 6, cancellation of claims 9-55, and addition of claims 56-58 by applicant on August 11, 2004 are hereby acknowledged.

### ***Election/Restriction***

3. New claims 57 and 58 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to non-elected inventions (Inventions V and VI, respectively), there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper N<sup>o</sup> 7.
4. This application now contains withdrawn claims 57 and 58, drawn to inventions non-elected with traverse in Paper N<sup>o</sup> 7. A complete reply to this final rejection *must* include cancellation of the non-elected claims or other appropriate action (37 CFR 1.144). See MPEP § 821.01.

***Information Disclosure Statement***

5. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

***Claim Objections***

6. New claim 56 is objected to because of the following informalities: it appears that "the intrinsic descriptors" (line 1) was intended to be --the descriptors-- (as in claim 1), which change will be assumed for purposes of further consideration of the claims hereinafter. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e)<sup>1</sup> the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

8. Claims 1-8 and 56 are rejected under 35 U.S.C. 102(e) as being anticipated by Kolawa et al. (US 6,370,513).

Kolawa et al. disclose a system for recommending a consumer product selection across a network, the system comprising: a recommendation engine comprising a first module (portion of functional descriptive material) for determining a difference between a plurality of consumer products having a plurality of descriptors by differentiating between at least one descriptor of the consumer products and providing the difference to a computer module; a descriptor module (portion of functional descriptive material) for receiving descriptor input regarding the plurality of descriptors of at least a consumer product from at least two independent nodes on the network; a second module (portion of functional descriptive material) coupled to the recommendation engine for sorting between each of the consumer products to form at least two classes of the consumer products; a third module (portion of functional descriptive material) coupled to the recommendation engine for determining, for each consumer product, a correlation

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<sup>1</sup> The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) apply to the examination of this application as the application being examined was (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) as amended by the AIPA (post-AIPA 35 U.S.C. 102(e)).

between the at least two classes and each of the descriptors, assigning a weighting term for each descriptor based upon the ability of each descriptor to sort between the at least two classes; and, a fourth module (portion of functional descriptive material) coupled to the recommendation engine for cooperatively operating on the weighting terms to provide a recommendation.

Regarding claims 2-3, the nature of the particular consumer product being recommended by the system (wine, perfume, etc.) has been deemed merely a “for use” application of the claimed invention, hence, afforded little patentable weight (Kolawa et al. do, however, disclose a wine embodiment).

Regarding claim 4, each of the descriptors of the system of Kolawa et al. is (inherently) either an intrinsic (non-extrinsic) descriptor or an extrinsic (non-intrinsic) descriptor.

Regarding claims 5-6, each of the descriptors of the system of Kolawa et al. is in digital format, and is (inherently) either streaming (non-static) or static (non-streaming).

Regarding claim 7, the system of Kolawa et al. utilizes cluster mapping to generate the correlations between the consumer products and the at least two classes (see, in particular, column 12, line 35, to column 13, line 14).

Regarding claim 8, the network 12 of the system of Kolawa et al. is the Internet.

Regarding claim 56, the recited functional language characterizing the nature of the particular non-functional descriptive material being operated on by the claimed apparatus has been deemed merely intended usage of the claimed invention, hence, afforded little patentable weight. A recitation of the intended use of the claimed invention must result in a structural

difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See MPEP §2114.

*Response to Arguments*

9. Applicant's arguments filed August 11, 2004 have been fully considered but are not persuasive.

10. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "independently receiving the descriptors for a product...") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

11. Regarding the argument that Kolawa et al. fail to teach receiving the descriptors for a product from a plurality of independent nodes, the system of Kolawa et al. indeed includes receiving the descriptors for a product from a plurality of independent nodes, since the system allows retailers (plural) to submit descriptors about various products and services to the system database, which products and services can then be recommended to users of the system, based on a comparison to the preferences of users. See, for example, column 5, lines 2-6.

12. Regarding the argument that the recommendation engine of Kolawa et al. recommends items solely on the basis of a user's preferences, the system of Kolawa et al. necessarily, thus inherently, makes recommendations based not solely on the preferences of a user, but rather, based on the preferences of the user, the descriptors of a product, and the comparison between the two. Obviously, the system of Kolawa et al. could not make a recommendation based solely on knowing what a user likes, because the system *must* also know what a particular product or service was like. As a simple example, if the system of Kolawa et al. knew that a user's wine preference was for white wine, that information alone would be insufficient to make a recommendation, since the system would not be able to recommend a particular wine without knowing whether the particular wine was red or white.

13. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., scaling coefficients derived using "the claimed process") are not recited in the rejected claim(s), since the rejected claims(s) are not drawn to apparatus, not a process. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, regarding functional language or intended use recitations in apparatus claims, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the



claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See MPEP §2114.

Moreover, as stated by applicant (page 6), with emphasis added, “Kolawa broadly discloses the use of scaling coefficients for use with the user preference vector and/or the product preference vector *based on its impact* on a user’s taste and/or a product characteristic.” Therefore, Kolawa et al. indeed disclose using weighting terms for descriptors of products that are “based on the ability of the descriptor to sort” between the classifications of products.

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to the disclosure.

15. Applicant’s amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

16. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(703) 305-1525**, and whose facsimile number is **(703) 746-3976**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

Inquiries of a general nature or simply relating to the status of the application should be directed to the receptionist, whose telephone number is **(703) 308-1113**.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski, can be reached at **(703) 308-5183**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306** (fax-back auto-reply receipt service provided). Mailed replies should be addressed to "Commissioner of Patents and Trademarks, Washington, DC 20231." Hand delivered replies should be left with the receptionist on the seventh floor of Crystal Park Five, 2451 Crystal Dr, Arlington, VA 22202.

GJOC

October 29, 2004

 (11-15-04)

Gerald J. O'Connor  
Patent Examiner  
Group Art Unit 3627